

Notice of Allowability

Application No.

10/803,391

Examiner

Robert Sellers

Applicant(s)

GRAY ET AL

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 10 January 2005.
2. ☒ The allowed claim(s) is/are 16-20.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

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1. The following is an examiner's statement of reasons for allowance:

The obviousness-type double patenting rejection over U.S. Patent No. 6,641,923 is rescinded since the patent is the later filed application (the filing date of the patent is July 31, 2001 and effective filing date of the application is February 8, 2001), the applicant could not have filed the conflicting claims in a single application, and an administrative delay on the part of the Office caused the later filed application to issue first. Accordingly, a two-way test for obviousness is required (MPEP § II.B.1.(b)).

The conflicting claims could not have been filed in a single application because the patent requires the additional presence of a boron-containing compound. The specification of the application does not mention a boron-containing compound. Therefore, neither the instant application nor that of the patent could support both the instantly claimed composition without the boron-containing compound and the claims of the patent defining a boron-containing compound.

The Office caused an administrative delay due to a requirement for restriction in parent application no. 09/858,280 (mailed January 21, 2003) which necessitated the filing of the instant divisional application, along with the indication of allowability (mailed January 21, 2004) only after the filing of an appeal brief (filed December 24, 2003).

The obviousness-type double patenting rejection cannot satisfy a two-way test because there is no motivation to incorporate the boron-containing compound of the patent into the composition of the application.

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The sole remaining rejection is the obviousness-type double patenting rejection over application no. 10/288,791. According to MPEP § 822.01, the section entitled "Only Provisional Double Patenting Rejection Remaining in One Application,"

"[i]f the 'provisional' double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the 'provisional' double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent. See also MPEP § 804.01 and § 822."

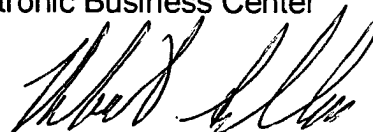
The obviousness-type double patenting rejection involving application no. 10/288,791 is hereby withdrawn, permitting the claims of the instant application to be allowed. The claims of application no. 10/288,791 have yet to be subjected to examination.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled

"Comments on Statement of Reasons for Allowance."

(571) 272-1093 (Fax no. (703) 872-9306)
Monday to Friday from 9:30 to 6:00 EST

Any administrative inquiries can be obtained by accessing the Patent Application Information Retrieval (PAIR) system. Published applications are available through either private or public PAIR. Unpublished applications are available via private PAIR only. Consult <http://pair-direct.uspto.gov> or contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).



Robert Sellers
Primary Examiner
Art Unit 1712

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1/28/05